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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/550,435	09/20/2005	Douglas McBain	OMNZ 2 00039 US	9981

7590 08/31/2009
Chief Intellectual Property Counsel
OMNOVA Solutions Inc.
175 Ghent Road
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EXAMINER

LIU, XUE H

ART UNIT	PAPER NUMBER
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1791

MAIL DATE	DELIVERY MODE
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08/31/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

DETAILED ACTION

Response to Amendment

1. Amendment to the claims filed on 8/21/09 is acknowledged. Currently, claims 1-4 and 7-19 are pending. Claims 5-6 have been cancelled. Claims 10-19 stand withdrawn. Claims 1-2 and 7-8 are currently amended.

Claim Rejections - 35 USC § 112

2. Objection to claim 8 under 112, first paragraph and objection to claims 7-8 under 112, 2nd paragraph in the previous office action are withdrawn in view of amendment to the claims.

Response to Arguments

3. Applicant's arguments filed 8/21/09 have been fully considered but they are not persuasive, therefore the grounds of rejection as set forth in the previous office action are maintained.

4. Regarding applicant's argument that one skilled in the art would not be motivated from the combination of Keiji and Arai to arrange a molding apparatus as is presently claimed, the test under 35 USC 103 is not what the reference expressly or individually teach, but what their combined teaching would fairly have suggest to a person skilled in the art.

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The suggestion of motivation, however, need not be specifically disclosed in references. See *In re Nilssen*, 7 USPQ 2d 1500 (Fed. Cir. 1988). The suggestion or motivation is defined not only in the context of the scope and content of the prior art references but also in the context of the level of one of ordinary skill in the art. *Graham v. John Deere Co.*, 148 USPQ 459 (Sup. Ct. 1963). That is, references are evaluated by what they suggest to one versed in the art rather than by their specific disclosure. See *In re Bozek*, 163 USPQ 545 (CCPA 1969); *In re Boe*, 148 USPQ 507 (CCPA 1966); *In re Preda*, 159 USPQ 342 (CCPA 1968); and *In re Shepard*, 138 USPQ 148 (CCPA 1963). The key to resolving the question of obviousness is therefore, dependent on the level of one skilled in the art. An artisan is presumed to have skill rather than a lack of skill. See *In re Sovish*, 226 USPQ 771 (Fed. Cir. 1985). The level of one skilled in the art, albeit not specifically defined due to its transient nature, encompasses at least engineering logic and common sense logic applicable in the art in addition to those disclosed in the prior art reference. In *Sjolund v. Musland*, 6 USPQ 2d 2020 (Fed. Cir. 1988), the prior art showed use of a certain single net panel while the claim called for two or more panels. Arguably, no obviousness was found because no explicit suggestion was provided to the modification of said single net panel into multiple net panels. Nevertheless, such a difference was held to be minor and within the ken of a routineer, *id.* at 2026. This court must have presumed that one of ordinary skill in the art knows something about the art apart from what the references alone teach, see *In re Bode*, 193 USPQ 12, 16 (CCPA 1977), and can be motivated by economics to depart from the prior art's teaching, see *In re Clinton*, 188 USPQ 365, 367 (CCPA 1976); *In re Thompson*, 193 USPQ 275, 277 (CCPA 1976). Additionally, one of ordinary skill in the art is presumed to have knowledge of all art within the field of his endeavor and in analogous arts. See *In re Wood*, 202 USPQ 171

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(CCPA 1979) regarding the determination of what constitutes analogous art. Therefore, applicant's argument that the prior art references provide no explicit suggestion to the modification of an injection molding injector with two nozzles each fluidly connected to one mold cavity into an injection molding injector with a single nozzle fluidly connected to each of the plurality of mold cavities is not persuasive since the Federal Circuit's predecessor court, the CCPA, has repeatedly held that presumption of obviousness was formed, based on the ken of routineer, whenever a difference was deemed minor.

Applicant also argues that the shape of the runner section affects the function of the claimed device, which is not taught not in Keiji or Arai. Applicant argues that the particular configuration of the runner as recited in the claim is patentably distinguished from the prior art since the claimed runner section promotes better flow distribution of the coating.

The MPEP states that "[r]ebuttal evidence may also include evidence that the claimed invention yields unexpectedly improved properties or properties not present in the prior art." A showing of unexpected results must be based on evidence, not argument or speculation. In re Mayne, 104 F.3d 1339, 1343-44, 41 USPQ2d 1451, 1455-56 (Fed. Cir. 1997) (conclusory statements that claimed compound possesses unusually low immune response or unexpected biological activity that is unsupported by comparative data held insufficient to overcome prima facie case of obviousness). Therefore, the applicant can not effectively prove that the claimed invention is superior than the prior art invention by changes in shape of the runner to produce unexpected result such as improved flow distribution of the coating material without showing comparative data in support of the argument. Secondary consideration will not be given to the claims unless proof of unexpected result can be shown that the particular claimed runner shape

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significantly improves the flow distribution of the coating composition compared to the prior art device.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to XUE LIU whose telephone number is (571)270-5522. The examiner can normally be reached on Monday to Friday 9:30 - 6:00 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Katarzyna Wyrozebski can be reached on (571)272-1127. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/KAT WYROZEBSKI/
Supervisory Patent Examiner,
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/X. L./

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Examiner, Art Unit 1791